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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,695	11/06/2001	Mark Guy Trowbridge	DN1999119USA	1290

7590 02/26/2004

The Goodyear Tire & Rubber Company
Patent and Trademark Department
1144 East Market Street
Akron, OH 44316-0001

EXAMINER

PEZZLO, BENJAMIN A

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,695

Applicant(s)

TROWBRIDGE, MARK GUY

Examiner

Benjamin A Pezzlo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief 5 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koeske et al. (US6250613).

Koeske et al. disclose an air spring for absorbing and transmitting shock loads between parts moveable relative to one another, the air spring including a flexible cylindrical sleeve 102 which is secured at each end to form a fluid chamber therein, a piston 94, the sleeve being secured to one end to a retainer 32 and being secured at the opposing end by the piston, the air spring being characterized by the retainer being integrally formed with the intermediate ribbed reinforcement structure 10 to strengthen the retainer (claim 1 or per claim 9, formed as a unitary article: note that the assembled air spring of Koeske et al. provides an integrally formed or unitary retainer/intermediate ribbed reinforcement structure) allowing for direct mounting of the air spring to one of the moveable parts (see col. 4 lines 56-59), the intermediate ribbed reinforcement structure of the retainer comprising an outer plate (see col. 1 line 9: note that the spacer can be used for the bead plate 16, thus a structure congruent to outer plate 18 would be used for the bead plate side) and an inner plate 46 which are parallel to each other, and a plurality of ribs 56 that extend between the outer plate and the inner plate.

Alternatively, the claim terminology "integrally formed" of claim 1 and/or "unitary" of claim 9 indicates that the retainer/intermediate ribbed reinforcement structure is manufactured as a single piece. With respect to such an interpretation, note that Koeske et al.'s recited need for a separate spacer is that a wide variety of shapes and sizes of air springs exist to fit the numerous suspension system configurations. It follows that prior to the introduction of Koeske et al.'s spacers, the industry provided retainers with ribbed reinforcement structures built right in, in other words, retainer/intermediate ribbed reinforcement structures manufactured as single pieces. Necessarily then, a combination including a retainer/intermediate ribbed reinforcement structure manufactured as a single piece is inherent to the disclosure, albeit of the prior art, of Koeske et al.

Moreover, MPEP 2144.04.V.B cites case law to the effect that only where insight contrary to the understandings and expectations of the art does providing a one-piece construction rise above being merely a matter of obvious engineering choice. In this case, providing a one-piece retainer/ribbed reinforcement structure fails to demonstrate such insight since arrival at such a structure requires merely practicing what was known prior to making retainers and ribbed reinforcement structures separately. In other words, it would have been obvious to one of ordinary skill in the art to which the invention pertains at the time the invention was made to have provided the retainer of Koeske et al. as a one piece construction as a matter of obvious engineering choice.

Re claim 2, see ribs 56.

Re claim 3, Fig. 3.

Re claim 4, see ribs 82.

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Re claim 10, Fig. 3.

Re claim 11, see ribs 82.

3. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al.

Koeske et al. fail to disclose the characteristics of the materials which make up the retainer. Nonetheless, where the only difference between the prior art and the claims is a recitation of specific dimensions and the device having the claimed dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems*, 220 USPQ 777 (Fed. Cir. 1984), See MPEP 2144.04.IV.A. Here, the claimed dimensions do not cause the claimed invention to function differently than the device disclosed by Koeske et al. It would have been obvious to one of ordinary skill in the art to which the invention pertains at the time the invention was made to provide the device of Koeske with the claimed tensile and flex strengths in order to provide sufficient mechanical strength to the device.

Re claim 6, see col. 3 line 42.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. in view of Geno et al. (US 4946144).

Koeske et al. do not disclose air inlet means extending through the intermediate ribbed reinforcement structure. Geno et al. disclose a retainer including ribs (see col. 4 lines 50-58) and air inlet means extending therethrough. It would have been obvious to one of ordinary skill in the art to which the invention pertains at the time the invention was made to have provided the

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retainer of Koeske with air inlet means extending through the ribbed reinforcement structure thereof in order to provide the spring with adjustable internal pressure.

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A Pezzlo whose telephone number is (703) 306-4617. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Handwritten signature of Benjamin A. Pezzlo and the date 2/25/04.

Benjamin A Pezzlo
Examiner
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BAP
February 25, 2004